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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/615,227	07/08/2003	Ricardo Sasso	3076-4	8530

7590 05/16/2005

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EXAMINER

JUNG, WILLIAM C

ART UNIT

PAPER NUMBER

3737

DATE MAILED: 05/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/615,227

Applicant(s)

SASSO, RICARDO

Examiner

William Jung

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 08 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on July 8, 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 08072003, 01062004, 17062004, 03012005
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Double Patenting

1. Claims 1-35 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-30 of copending Application No. 10/124,291. Although the conflicting claims are not identical, they are not patentably distinct from each other because the invention claimed in 10/124,291 (from here will be referred to as '291) is substantially same as invention claimed in current application. In claims 1 and 10 of '291 disclose of invention where a method includes performing image-guided spinal surgery on a patient by mounting a surgical navigation reference device to a bone at a location remote from the patient's spinal column and in a substantially fixed position relative to the spinal column where the fixation of the reference device is adjacent on the anterior of the patient. Dependent claims 2-9 and 11-21 of '291 disclose the feature elements in the claims 2-18, 20-29, and 31-35.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 11-13, 17-19, 26-30 and 32-35 are rejected under 35 U.S.C. 102(e) as being anticipated by *Melkent et al* (US 6,796,988 B2).

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Melkent et al anticipates all claimed features in claims 1, 11-13, 17-19, 26-30 and 32-35.

Claims 1, 19, and 30: Melkent et al disclose a method for performing image-guided spinal surgery on a patient including surgical reference device that is mounted or fixed to bone at a location remote from the patient's spinal column and relatively in anterior direction to perform image-guided surgery (col. 6, lines 6-45; col. 6, line 62 – col. 7, line 16).

Claims 7, 10, 11, 14-16, and 18: Melkent et al disclose further the method of mounting described above where the anchoring of surgical reference device is fixedly attached to the spinal elements. Although, the spinal element is a broad term, it includes bone structure as shown in Justis et al where the anchoring of fixing device such as screw or pin as shown in figure 1 is inserted percutaneously

Claims 11-13, 17, 18, 26-29, and 32-35: Melkent et al disclose guide 130 with passage 132 where the device may remove bone or parts of bone in the spinal column by insertion or incision to the region of interest. The device may be used for implantation of spinal implant (col. 6, lines 14-23; col. 6, line 62- col. 7, line 16; col. 7, line 56 – col. 8, line 19).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2-6, 20-23, and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Melkent et al.*

Melkent et al substantially disclose all claimed features in claims 2-6, 20-23 and 31.

Although Melkent et al do not explicitly state that the mounting occurs at pelvic bone, the lower end of the spinal column overlaps the pelvic bone. Therefore, it would have been obvious on one having an ordinary skill in the art at the time the invention was made to adjust the location of the mounting anywhere along the spinal column that may require fixation to the pelvic bone.

6. Claims 7-10, 14-16, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over *Melkent et al* as applied to claims 1 and 19 above, and further in view of *Justis et al* (US 6,530,929 B1).

Melkent et al substantially disclose all claimed features in claims 7-10, 14-16, 24, and 25. However, Melkent broadly disclose the anchoring as fixing the reference device to the spinal column, but do not explicitly disclose the anchoring to a bone. Although, the spinal element is a broad term, it includes bone structure as shown in Justis et al where the anchoring of fixing device such as screw or pin as shown in figure 1 is inserted percutaneously inserting the anchoring pin or screw into the patient where the pin or screw 60a and 60b are inserted into the bone. Therefore, it would have been obvious to one having an ordinary skill in the art at the time the invention was made to apply the teachings of Justis et al's bone anchoring device bones in spinal column to Melkent et al's method to achieve the claimed invention.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to William Jung, Ph.D. whose telephone number is 571-272-4739. The examiner can normally be reached on Mon-Fri 8:30 AM to 5 PM.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brian Casler can be reached on 571-272-4956. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WCS

April 1, 2005


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